

REMARKS

I. Status and Disposition of the Claims

In the instant application, claims 1-52 are pending and under consideration on the merits. Of the claims pending, claims 1, 5, 8, 11, 14, 21, 24, 27, 34, 37, 40, 43-47, and 50 have been amended.

In the Non-final Office Action mailed March 15, 2010, (hereinafter "Office Action"),¹ the following actions were taken:

- a. claim 46 was objected to based on informalities;
- b. claims 1-13, 27-39, and 40-52 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter;
- c. claims 40-52 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite;
- d. claims 1-3, 5-7, 14-16, 18-20, 27-29, 31-33, 40-42, and 44-46 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,343,290 to Cossins et al. (hereinafter "Cossins"); and
- e. claims 4, 8-13, 17, 21-26, 30, 34-39, 43, and 47-52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cossins in view of Metacrawler Parallel Web Search Service, Reformatted Metacrawler Query Submission Form: Metacrawler Query Syntax, 05-18-1997, <http://www.hicom.net/~oedipus/meta3.html>, pgs 1-2 (hereinafter, "Metacrawler"), and Quick Reference Guide to Search Engine Syntax, 04-07-2001, http://www.utm.edu/departments/acadpro/library/information_pages/syntax.html, pgs 1-10 (hereinafter, "Guide").

II. Amendments to the Claims

Independent claim 1 has been amended to include the following element:

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

receiving a query for defining a geographic area wherein the query comprises an indication of at least one of a set of subregions and a set of sections, wherein the indication comprises at least one symbol associated with at least one of reducing the number of subregions within the set of subregions, and reducing the number of sections within the set of sections;

(Emphasis added). Claims 8, 11, 14, 21, 24, 27, 34, 37, 40, 47, and 50 have been similarly amended. Support for this amendment may be found at least in Applicant's Specification at paras. [0028] and [0036]. Accordingly, no new matter has been introduced by this amendment.

III. Claim Objections

In the Office Action, the Examiner objected to an informality in claim 46. Particularly, the Examiner noted that claim 46 depended from claim 5, when the Applicant may have instead intended for claim 46 to depend from claim 44. Accordingly, appropriate correction was requested.

Applicant has appropriately amended claim 46 to depend from claim 44, and respectfully requests that the Examiner withdraw the above-identified objection to claim 46.

IV. Rejections under 35 U.S.C. § 101

In the Office Action, the Examiner rejected claims 1-13 and 40-52 under 35 U.S.C. § 101 as being directed to non-statutory subject-matter. Office Action at pages 2-5. Without agreeing with the Examiner's contentions and characterizations, and in the interest of expediting prosecution, Applicant has amended independent claim 1 to

positively recite a machine that accomplish its method steps. Independent claims 8, 11, 40, 47 and 50 have been similarly amended. Dependent claims 2-7, 9-10, 12-13, and 48-49, 51-52 depend from independent claims 1, 8, 11, 40, 47, and 50 and, by virtue of their dependence, contain the above-identified elements. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-13 and 40-52 under 35 U.S.C. § 101.

Additionally, in the Office Action, the Examiner rejected claims 27-39 under 35 U.S.C. § 101. Again, without agreeing with the Examiner's contentions above, and in the interest of expediting prosecution, Applicant has amended independent claims 27, 34, and 37 as suggested by the Examiner. Consequently, Applicant respectfully requests that the Examiner withdraw the rejection of claims 27-39 under 35 U.S.C. § 101.

V. Rejections under 35 U.S.C. § 112

The Examiner rejected claims 40-52 under 35 U.S.C. § 112, second paragraph, for "failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention." Office Action at page 5. Particularly, the Examiner objects to the "means for" language in the claims. *Id.* at pages 5-6. Without agreeing with the Examiner's contentions and characterizations, and in the interest of expediting prosecution, Applicant has amended claims 40-52 such that these claims no longer contain the "means-plus-function" language previously present. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 40-52 under 35 U.S.C. § 112.

VI. Rejections under 35 U.S.C. § 102(e)

1. Claims 1-3, 5-7, 14-16, 18-20, 27-29, 31-33, 40-42, and 44-46 are not anticipated by Cossins.

The Examiner rejected claims 1-3, 5-7, 14-16, 18-20, 27-29, 31-33, 40-42, and 44-46 under 35 U.S.C. §102(e) as anticipated by Cossins. Applicant respectfully traverses this rejection.

In order to properly establish that Cossins anticipates Applicant's claimed invention under 35 U.S.C. § 102(e), each and every element of the claims at issue must be found, either expressly described or under principles of inherency, in Cossins. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Here, Cossins does not contain a teaching or disclosure of at least the following elements of Applicant's claim 1.

First, independent claim 1, as amended, is directed to a method and recites, among other acts, "receiving a query ... compris[ing] an indication of at least one of a set of subregions and a set of sections, the indication comprising at least one symbol associated with at least one of reducing the number of subregions within the set of subregions, and reducing the number of sections within the set of sections." (Emphasis added)." Cossins fails to teach or suggest at least this element of the claim.

The Examiner contends that Cossins at col. 15, line 64 - col. 16 teaches "receiving a query for defining a geographic area wherein the query includes an indication of at least one of a set of subregions and a set of sections." Office Action at

page 7. Even if the Examiner were correct, which Applicant does not concede, Cossins does not teach or suggest an indication “comprising at least one symbol associated with at least one of reducing the number of subregions within the set of subregions, and reducing the number of sections within the set of sections,” as further recited in Applicant’s amended claim 1. Indeed Cossins does not disclose anything analogous to a symbol associated with reducing the number of subregions within a set of subregions, or a symbol associated with reducing the number of sections within a set of sections. Consequently, Cossins does not and cannot teach or disclose “receiving a query ... compris[ing] an indication of at least one of a set of subregions and a set of sections, the indication comprising at least one symbol associated with at least one of reducing the number of subregions within the set of subregions, and reducing the number of sections within the set of sections,” as recited in Applicant’s amended claim 1.

Second, independent claim 1 additionally recites, among other acts, the acts of:

determining whether the reference to at least one of the set of subregions and the set of sections indicates the at least one of the set of subregions and the set of sections are to be included in the geographic area;

and

determining whether the reference to the at least one of the set of subregions and the set of sections indicates the at least one of the set of subregions and the set of sections are to be excluded from the geographic area.

Cossins fails to teach or suggest at least the above-identified determining acts.

The Examiner first contends that Cossins discloses “determining whether the reference to at least one of the set of subregions and the set of sections indicates the at least one of the set of subregions and the set of sections are to be included in the

geographic area.” (Emphasis added). Office Action at page 8. Specifically, the Examiner contends, without referring to any particular portions of Cossins, that the above-identified element of claim 1 is “inherent via the search or query feature to determine the region being searched for.” *Id.* The Examiner next contends that Cossins discloses “determining whether the reference to the at least one of the set of subregions and the set of sections indicates the at least one of the set of subregions and the set of sections are to be excluded from the geographic area.” (Emphasis added). *Id.* And again, without referring to any particular portions within the Cossins reference, the Examiner asserts that the above-identified element of claim 1 is taught “inherently via a query or search in the case that the search or query fails to find a match.” *Id.*

Cossins discloses a system for managing a cell network, to which a user browser transmits search criteria, including addresses, intersections, and cell sites. A map server associated with the system subsequently generates one or more geocodes (e.g. latitudes and longitudes) associated with the search criteria, to obtain network data and geospatial data from a database server. See Cossins, col. 1, lines 31-43; col. 5, lines 20-28; col. 6, lines 28-30. The network data includes cell site information, such as regions, markets, site identification information, and antenna height. The geospatial data includes geographic and/or spatial data. See Cossins, col. 3, lines 19-24, 32-40. The obtained data are then transmitted to the user browser and displayed as a map displaying network elements of a telecommunication network relative to other network elements, geographic elements, and customers. See Cossins, col. 1, lines 31-43.

Despite disclosing the above-identified information, Cossins does not, however, contain any teaching or suggestion, explicit or implicit, of a determination as to whether a reference to a set of subregions or sections indicates inclusion with or exclusion from a geographic area. Even assuming *arguendo*, that Cossins' network and geospatial data are somehow analogous to Applicant's "set of subregions" or "set of sections," the Cossins' network data and geospatial data are both obtained from a database server and displayed on the user browser without any such determination with regard to inclusion within or exclusion from a geographic area. Moreover, even under principles of inherency, a determination on whether a reference to a set of subregions and/or a set of sections indicates inclusion in or exclusion from a geographic area does not necessarily flow from Cossins' general disclosure of an entirely different system where search criteria is used to generate network and geospatial data that are thereafter displayed as a map of network elements of a telecommunication network.

For at least the reasons identified above, Cossins does not teach or disclose (1) "determining whether the reference to at least one of the set of subregions and the set of sections indicates the at least one of the set of subregions and the set of sections are to be included in the geographic area," or (2) "determining whether the reference to the at least one of the set of subregions and the set of sections indicates the at least one of the set of subregions and the set of sections are to be excluded from the geographic area," as recited in Applicant's amended claim 1.

For at least the reasons presented above, amended claim 1 is not anticipated by Cossins. Independent claims 14, 27, and 40, although of different scope, contain elements similar to those of claim 1 that are not disclosed by Cossins. Therefore, like

claim 1, claims 14, 27, and 40 are also patentable over Cossins. Dependent claims 2, 3, 5-7, 15, 16, 18-20, 28, 29, 31-33, 41, 42, and 44-46 are also patentable over Cossins, at least by virtue of their dependence from claims 1, 14, 27, and 40. Applicant therefore respectfully requests that the Examiner withdraw the rejection of claims 1-3, 5-7, 14-16, 18-20, 27-29, 31-33, 40-42, and 44-46 under 35 U.S.C. § 102(e).

VII. Rejections under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected claims 4, 8-13, 17, 21-26, 30, 34-39, 43, and 47-52 under 35 U.S.C. § 103(a) as being unpatentable over Cossins in view of Metacrawler and Guide. Applicant respectfully traverses these rejections, and notes that a *prima facie* case of obviousness has not been established.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious [R]ejections on obviousness cannot be sustained with mere conclusory statements.” MPEP § 2142, 8th Ed., Rev. 7 (July 2008) (internal citation and inner quotation omitted) (emphasis added). “[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” MPEP § 2141(II). In rejecting a claim, “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” MPEP § 2141(III).

Here, as detailed below, a *prima facie* case of obviousness has not been established with regard to any of the rejected claims. The scope and content of the prior art has not been properly determined, and therefore, the differences between the claimed invention and the prior art has not been properly ascertained. Accordingly, there has been no clear articulation of the reasons why the prior art would serve to render the claimed invention obvious to one of ordinary skill in the art.

Independent claim 8, as amended, is directed to a method and recites, among other acts, “receiving a query ... wherein the query comprises an indication of at least one of a set of states and a set of postal codes, the indication comprising at least one symbol associated with at least one of reducing the number of states within the set of states, and reducing the number of postal codes within the set of postal codes.” Cossins, Metacrawler, and Guide, alone or in combination, fail to teach or suggest at least the receiving act recited above.

The Examiner appears to contend that Cossins’ disclosure of a user being able to “search with any component of an address, including a street address, an intersection, a city, a state, or a zip code,” (Cossins, col. 20, lines 19-23) teaches Applicant’s “receiving a query ... wherein the query comprises an indication of at least one of a set of states and a set of postal codes,” as recited in amended claim 8. See Office Action at pages 8 and 12. Even if the Examiner is correct in so contending, which Applicant does not concede, the Examiner neither contends that Cossins teaches nor does Cossins in fact teach, an “indication comprising at least one symbol associated with at least one of reducing the number of states within the set of states, and reducing

the number of postal codes within the set of postal codes,” as further recited in amended claim 8.

Additionally, in the context of amended claim 1, Applicant has already shown that Cossins does not teach or disclose an “indication comprising at least one symbol associated with at least one of reducing the number of subregions within the set of subregions, and reducing the number of sections within the set of sections,” at least because Cossins fails to disclose anything analogous to a symbol associated with reducing the number of subregions within a set of subregions, or a symbol associated with reducing the number of sections within a set of sections. Similarly, in the context of amended claim 8, Cossins fails to disclose anything analogous to a symbol associated with reducing the number of states within a set of states, or a symbol associated with reducing the number of postal codes within a set of postal codes. Therefore, it follows that Cossins fails to also teach or disclose “receiving a query ... wherein the query comprises an indication of at least one of a set of states and a set of postal codes, the indication comprising at least one symbol associated with at least one of reducing the number of states within the set of states, and reducing the number of postal codes within the set of postal codes,” as recited in Applicant’s amended claim 8.

The Examiner does not contend that Metacrawler and/or Guide teaches or discloses the following elements of claims 1 and 8 that are not disclosed by Cossins: (1) an “indication comprising at least one symbol associated with at least one of: reducing the number of subregions within the set of subregions, and reducing the number of sections within the set of sections,” as recited in amended claim 1, and (2) an “indication comprising at least one symbol associated with at least one of reducing the number of

states within the set of states, and reducing the number of postal codes within the set of postal codes,” as recited in amended claim 8. Indeed, Metacrawler and Guide, alone or in combination, cannot be applied to cure the above-identified deficiencies of Cossins.

For at least these reasons, Cossins, Metacrawler and Guide, alone or in combination, fail to render obvious Applicant’s amended claims 1 and 8. Independent claims 11, 21, 24, 34, 37, 47, and 50, although of different scope, contain elements similar to those of claim 1 or claim 8 that are not disclosed by these references. Therefore, like independent claims 1 and 8, claims 11, 21, 24, 34, 37, 47, and 50 are also patentable over these references. Dependent claims 4, 9, 10, 12, 13, 17, 22, 23, 25, 26, 30, 35, 36, 38, 39, 43, 48, 49, 51, and 52 are also patentable over Cossins, Metacrawler, and Guide at least by virtue of their dependence from the above-identified independent claims. Applicant therefore respectfully requests that the Examiner withdraw the rejection of claims 4, 8-13, 17, 21-26, 30, 34-39, 43, and 47-52 under 35 U.S.C. § 103(a).

VIII. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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